

**REMARKS**

1. Claims 13-24 are currently pending in the application, as amended. Claims 1-12 have been cancelled without prejudice and are made without prejudice to the Applicant's rights to file to otherwise present claims of a similar or broader scope as those previously filed in a continuation application or otherwise. Claims 13-24 have been amended. The specification has been amended. Support for the amendment to the specification can be found in at least original claims 13-24. No new matter has been added.

***Claim Rejections – 35 U.S.C. § 102***

2. The Examiner has rejected claims 10-12 and 22-24 under 35 U.S.C. § 102(f) alleging the applicant did not invent the claimed subject matter. The Examiner asserts that such claims are directed to the “maximum set packing” and “comparison of two different pools” which were alleged by the Examiner to be invented by Ronald Armstrong. In support of this proposition, the Examiner cites to the Declaration by Applicant Under 37 C.F.R. 1.132, by Dmitry Belov, dated 9/26/2008 (“9/26/08 Belov Dec”). The 9/26/2008 Belov Dec describes the contributions of Ronald Armstrong to Belov, D. and Armstrong, R.D., *A Stochastic Search for Test Assembly, Item Pool Analysis, and Design*, (“Stochastic Search”). Applicant respectfully traverses this rejection as it pertains to claims 22-24.

First, the Examiner is correct in her assertion in paragraph 2 of the Office Action that the notion of maximum set packing appears on page 10 and a comparison of two different pools is found on page 11 with reference to the form of the Stochastic Search article submitted with the Information Disclosure Statement of September 9, 2004. Applicant's reference to pages 5 and 6 of the Stochastic Search article referred to a published form of the same article.

With regard to the “maximum set packing” contribution by Ronald D. Armstrong in the Stochastic Search article, none of the pending claims are directed to the maximum set packing formulation. Maximum set packing formulation is mentioned in paragraph [0235] of the as-published version of the present application, U.S. Patent Application Publication No. 2005/0186551 but is not claimed. The problem of identifying the “maximum subset of nonoverlapping forms” can be formulated and solved in many ways, including the two ways

mentioned in the Stochastic Search article, i.e. 1) identifying a maximum clique, and 2) identifying a maximum set packing, neither of which are specifically claimed. *See* the Declaration by Applicant under 37 C.F.R. § 1.132 (herein “Belov Dec”) submitted herewith at ¶ 4.

Regarding the “comparison of two different pools” contribution by Ronald D. Armstrong to the Stochastic Search article, none of the pending claims are directed to comparing two different pools. Claims 22-24 are directed to a pool of questions and corresponding sub-pools. *See* Belov Dec, ¶ 4.

Based on the above, Applicant submits that Dmitry I. Belov is properly listed as the sole inventor of the claimed subject matter and Ronald D. Armstrong has been properly excluded as an inventor of the currently pending claims as not having contributed to the conception of any of the pending claims.

Claims 10-12 have been cancelled, rendering their rejections moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw any rejection of claims 22-24 based upon 102(f).

3. The Examiner has rejected claims 1-2, 13 and 14 under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. The Examiner asserts that the mentioned use of the Monte Carlo approach in the article “Developing and Assembling the law School Admission Test” (“Developing and Assembling the LSAT”) constituted a public use more than one year prior to filing the present application. Applicant respectfully traverses this rejection as it relates to claims 13 and 14.

Developing and Assembling the LSAT refers to a 2002 implementation of an LSAT assembler utilizing an adaptive stochastic search approach. Belov Dec ¶ 6. The 2002 implementation referred to in this article was used for internal research purposes only, at least until one year before the filing date of the present application and was not used to assemble any test that was presented to, or taken by, anyone outside of the Law School Admission Council, the assignee of the present application, more than one year before the filing date of this application. Belov Dec ¶ 6. The test assembler implemented in 2002, and its method of operation, was not

disclosed to or accessible by anyone other than employees of or contractors to the Law School Admission Council more than one year before the filing date of the present application, all of whom were under an obligation to the Law School Admission Council to maintain information regarding the 2002 implementation confidential. Belov Dec ¶ 6.

Claims 1 and 2 have been cancelled, rendering their rejections moot. Based upon the above, Applicant respectfully requests that the Examiner reconsider and withdraw any rejection of claims 22-24 based upon public use under 102(b).

4. The Examiner has rejected claims 1-24 under 35 U.S.C. § 102(a) as being anticipated by Stochastic Search. The Examiner asserts that the 9/26/08 Belov Dec is insufficient to overcome the rejection of claims 1-24 based upon Stochastic Search because 1) the affidavit fails to provide objective evidence as to the proper date of Stochastic Search and 2) Armstrong's alleged contribution to Stochastic Search is claimed in claims 22-24. Applicant respectfully traverses this rejection as it pertains to claims 13-24.

First, Applicant respectfully submits that the Declaration of Lynda Reese under 37 C.F.R. 1.132 ( "Reese Dec"), submitted herewith, and the Declaration of Alison Weisberg ("Weisberg Dec") under 37 C.F.R. 1.132, submitted herewith, set forth objective evidence as to the proper date of Stochastic Search. The publication date of January 2004 listed for Stochastic Search in the Information Disclosure Statement submitted September 9, 2004 was listed in error. *See* Weisberg Dec ¶¶ 2 – 5. Stochastic Search was first disclosed to members of the Law School Admission Council Test Development And Research Committee during a meeting conducted on March 26, 2004. Reese Dec ¶ 2. Attached to the Reese Dec as Exhibit A is a true and accurate copy (redacted) of the minutes from the meeting on March 26, 2004, where the Board of Trustees discussed and approved publishing Stochastic Search. Reese Dec ¶ 3. Stochastic Search was published on [www.lsacnet.org](http://www.lsacnet.org) in September of 2006 and remains accessible today via [www.lsacnet.org](http://www.lsacnet.org). Reese Dec ¶ 4. The published version of Stochastic Search (attached as Exhibit B to the Reese Dec) refers to "Research Report 04-01." This means that Stochastic Search was presented to the Law School Admission Council Test Development and Research Committee during the Committee's first meeting of 2004, which was conducted on March 26, 2004. Reese Dec ¶ 4. Even if presentation of Stochastic Search to the Committee on March 26,

2004 constitutes a public disclosure, such a disclosure was after the filing date of the present application.

Second, Applicant respectfully submits that Armstrong is not a co-inventor of the presently pending claims as discussed in paragraph 2 above.

Claims 1-12 have been cancelled, rendering their rejections moot. Based upon the above, Applicant respectfully requests that the Examiner reconsider and withdraw any rejection of claims 13-24 based upon anticipation by the Stochastic Search article under 102(a).

***Claim Rejections – 35 U.S.C. § 101***

5. The Examiner has rejected claims 1-12 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-12 have been cancelled rendering the rejection under 101 moot.

***Request for Information Under 37 C.F.R. § 1.105***

6. The Examiner has requested additional information that the Examiner asserts is reasonably necessary to the examination of the present application.

In paragraph 2, the Examiner has requested that Applicant provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of test item sub-pool creation. In addition, for each of these articles, or those previously cited by the Applicant, the Applicant is requested to identify the contributions of each of the authors to the article. In response to this request, see Below Dec ¶ 7 and accompanying articles listed in the Supplemental Information Disclosure Statement submitted herewith.

In paragraph 3, the Examiner has requested that Applicant provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the Applicant's invention, particularly as to developing constraint analysis of a sub-pool. For each publication, the Examiner has requested that Applicant provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject

matter. In response to this request, see Below Dec ¶ 8 and accompanying articles listed in the Supplemental Information Disclosure Statement transmitted herewith.

In paragraph 4, the Examiner has requested that Applicant provide the names of any products or services that have incorporated the claimed subject matter. The Examiner requests that Applicant provide information concerning the operational algorithms employed in the product used by LSAC since 2002 referenced in Developing and Assembling the LSAT. Further, Applicant is requested to identify the similarities and differences, if any, that exist between this product and the presently claimed invention. In response to this request, see Below Dec ¶ 9.

### **CONCLUSION**

7. In view of the foregoing Amendment and remarks, Applicant respectfully submits that the present application, including claims 13-24, is in condition for allowance and such action is respectfully requested.

The Director is hereby authorized to charge any necessary fees, including extension fees under 37 C.F.R. § 1.17(a), or credit any overpayments in connection with this submission to Deposit Account No. **50-0310** (Billing No. 029279-5001).

Respectfully submitted,  
**MORGAN, LEWIS & BOCKIUS LLP**

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